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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/422,195 10/21/99 KANEVSKY

D 12837(Y0999-

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TM02/1102

EXAMINER

CHAMPAGNE, D

ART UNIT

PAPER NUMBER

2

2162

DATE MAILED: 11/02/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

T.R.

Office Action Summary

Application No.

09/422,195

Applicant(s)

KANEVSKY ET AL.

Examiner

Donald L Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 October 1999.
- 2a) ☐ This action is FINAL. -2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on 21 October 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 8-12, 23-27 and 36-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 8, 23 and 36 contain an improper Markush group (MPEP § 2173.05(h)I).

Claim Rejections - 35 USC § 102 and 35 USC § 103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-4, 7-10, 12, 13, 15-19, 22-25, 27-32, 35-38, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Deaton et al.
6. Deaton et al. teaches (independent claims 1, 16 and 29) a system, method and program storage device readable by a machine for generating a coupon, which reads on an advertisement, for one or more persons in a retail store, which reads on a public location, the method comprising: obtaining a customer's checking account number (col. 3 lines 63-65), which reads on obtaining data relating to one or more persons; collecting (transactional) data (col. 3 lines 58) based on said obtained data; developing customer profiles so as to perform targeted marketing (col. 3 lines 60-61), which reads on extracting common elements

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from said collected data and associating products and services for advertisements with said common elements, and generating an advertisement; and distributing a generated coupon to a customer at a point of sale (col. 66 lines 62-67), which reads on transmitting and communicating said optimized advertisement to said one or more persons.

7. Deaton et al. also teaches: (claims 2, 17 and 30) a database; (claims 3, 18 and 31) performing a product purchasing transaction (col. 3 line 58); (claims 4, 19 and 32) collecting a history of purchases (col. 3 line 59), which also reads on claims 7, 22 and 35 because purchasing is a behavioral characteristic, and updating said data (claims 9, 24 and 37, col. 4 line 10); (claims 8, 23 and 36) classifying by type of product involved in a current transaction (col. 70 lines 50-60); (claims 10, 25 and 38) selecting a targeted/optimized coupon/advertisement (col. 70 lines 60-68); (claims 12, 27 and 40) creation of a new coupon/advertisement (col. 70 lines 13-17); (claims 13, 28 and 41) a network (col. 4 lines 48-49); and (claim 15) a digital display (col. 10 lines 42-44).
8. Claims 11, 26 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Herz et al. Deaton et al. does not teach ranking. Herz et al teaches ranking (col. 1 lines 27-31). Because Herz et al. teaches that ranking improves the efficiency of targeting (col. 4 line 35 and col. 1 lines 46-48), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add ranking to the teachings of Deaton et al.
9. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Herz et al. and further in view of Scroggie et al. Neither Deaton et al. nor Herz et al. teach that the network is the Internet. Scroggie et al. teaches that the network is the Internet (col. 1 lines 42-43). Because Scroggie et al. teaches that it would enhance communication with both customers and suppliers (col. 1 lines 26-29 and col. 11 lines 52-53), it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Scroggie et al. to those of Deaton et al. and Herz et al.
10. Claims 5, 6, 20, 21, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Deaton et al. in view of Stinson et al.
11. Deaton et al. does not teach obtaining physical/biometric characteristics. Stinson et al. teaches obtaining physical/biometric characteristics (col. 2 lines 6-7). Because it would

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enhance security, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add the teachings of Stinson et al. to those of Deaton et al.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 703-308-3331. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications may be sent directly to the examiner at 703-746-5536.
13. The examiner's supervisor, Eric Stamber, can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular official communications and 703-746-7238 for After Final official communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



Donald L. Champagne
Examiner
Art Unit 2162

31 October 2001